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GOODWIN PROCTER LLP
PATENT ADMINISTRATOR
EXCHANGE PLACE
BOSTON, MA 02109-2881

| EXAMINER | |
|---|---|
| SMITH, RUTH S | |

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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 09/841,325
Filing Date: April 24, 2001
Appellant(s): MODELL ET AL.



Goodwin Procter, LLP
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 2, 2007 appealing from the Office action mailed August 24, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

| | | |
|---|---|---|
| 6,424,852 | ZAVISLAN | 7-2002 |
| 4,362,166 | FURLER | 12-1982 |
| 5,337,734 | SAAB | 8-1994 |
| 6,115,523 | CHOI et al | 9-2000 |
| 5,199,431 | KITTRELL et al | 4-1993 |
| 6,210,331 | RAZ | 4-2001 |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 105-107,109,110,115,125,126,152-156,159-160,165-167, 170,171 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Zavislan (6,424,852) in view of Furler et al or Saab or Choi et al. Zavislan discloses an optical system for diagnosing tissue using an illuminating and detecting arrangement. The tissue can be internal biological tissue as disclosed in column 7, lines 34-47. Zavislan discloses the use of the device on internal tissue such as cervical tissue. Zavislan clearly

distinguishes between cervical tissue and internal tissues that are surgically exposed. It is well known that the art that examination of cervical tissue does not require surgical exposure of the tissue. Zavislan fails to specifically disclose the use of a disposable device to protect the patient during scanning, however, the elements shown in figures 9-11 which prevent the imager 83 from contacting the tissue can comprise a disposable device such as a sheath. The sheath is capable of being used only a single time and can be disposed of. The imager used in the apparatus of Zavislan is disclosed as that of US Patent No. 5,788,639 which includes beam splitters/mirrors which are moveable with respect to the patient. Furthermore, the use of protective covers or disposable probes in the medical field is a well known expedient in order to prevent contamination. Examples of such are seen in Furler et al, Saab and Choi et al which disclose the use of a disposable sheath around a medical device to prevent contamination from one patient to another. It would have been obvious to one skilled in the art to have modified Zavislan such that the elements shown in figures 9-11 which prevent the imager 83 from contacting the tissue can comprise a disposable device such as a sheath in order to protect the patient from possible contamination.

Claims 108,111,113,118,119,121,123,148,150,162,168 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Zavislan in view of Furler et al or Saab or Choi et al as applied to claims 105,107,152 above, and further in view of Kittrell et al. Zavislan fails to disclose comparing the data obtained to a standard and the use of moveable mirrors to scan the tissue. It is well known in the medical art to obtain data from a tissue region and compare the data to at least one standard in order to properly diagnose the tissue region being tested. An example of such is seen in Kittrell et al. Kittrell et al disclose a method of optically analyzing tissue. Kittrell et al disclose illuminating the tissue using an optical assembly comprising moveable mirrors to focus the light on different regions of tissue. The structure set forth in claim 118,119 is seen in figure 23, elements 68,70. It would have been obvious to one skilled in the art to have further modified Zavislan such that the data obtained is analyzed by comparing such to a known standard in order to provide a diagnosis of the tissue being tested. Furthermore, it would have been obvious to have scanned the tissue sample by using

moveable mirrors rather than mechanically translating the imager. Such a modification involves the substitution of one known type of scanning means for another. With respect to claim 121 and 162, the specific field stop dimension used would have been an obvious design choice of known equivalents in the art.

Claims 116,117,122,124,163,164 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Zavislan ('852) in view of Furler et al or Saab or Choi et al and Kittrell et al as applied to claims 105, 108,152 above, and further in view of Raz. Raz discloses a confocal imaging system which uses an array of emitters and detectors in order to scan a large region of interest. It would have been obvious to one skilled in the art to have further modified Zavislan such that an array of detectors is used in order to scan a larger region of interest in a short time period. Inasmuch as Zavislan discloses the use of optical devices, the array of detectors would require the use of optical elements and processors. The use of an array of detectors and emitters would result in an array of field stops.

**(10) Response to Argument**

It is respectfully submitted, Zavislan clearly distinguishes cervical tissue from other internal tissue by use of the recitation of "internal tissues, for example which are surgically exposed". This language does not set forth that all internal tissues are surgically exposed. The use of the term "for example" clearly establishes Zavislan's intent, that all internal tissues are not surgically exposed. In fact, Zavislan equates cervical tissue to the tissue on the forehead in the use of the device as seen in column 7, lines 34-38.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Ruth S. Smith
Primary Examiner
Art Unit 3737

Conferees:

ANGELA D. SYKES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

Janet Baxter
TC 3700 TQAS